

Serial No.: 10/605,256
Confirmation No.: 2255
Applicant: NYLEN, Per
Atty. Ref.: 07589.0053.NPUS01

REMARKS:

REMARKS REGARDING CLAIMS AMENDMENTS:

Claims 20 and 21 have been added. Claim 1 has been amended to include limitations of Original Claim 9. Claim 7 has been amended to reflect the amendments to Claim 1. Claims 8 and 9 have been cancelled in light of the amendment to Claim 1. Claims 10, 11, and 12 have been amended to now depend from Claim 1.

REMARKS REGARDING ABSTRACT AMENDMENTS:

The Abstract has been amended to remove the legal phraseology as the Action requested.

REMARKS REGARDING TITLE:

Applicant believes that the title while short is descriptive of the invention as disclosed. The device as disclosed in the application is commonly referred to as a thermal spraying device.

IN RESPONSE TO THE OFFICE ACTION:

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1-6, 8-10, 13, 15-19 were rejected under 35 U.S.C. §102(b) as being anticipated by Landes (US 5,406,046).

Initially, it is important to be cognizant of the long-standing standard that anticipation under §102 can only be found if a reference shows exactly what is claimed. The identical invention must be shown in as complete detail as is contained in the patent claim. Furthermore, the elements must be arranged as in the claim under review.

Addressing the rejection under 35 U.S.C. §102: Examiner is reminded that for there to be anticipation under 35 U.S.C. §102, “each and every element” of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) (“absence from the reference of any claimed element negates anticipation.”); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990).

Applicant has amended Claim1 to include limitations found in Claim 9. This additional language concerns the holes that are radially oriented on the frame element. These holes, unlike that of Landes ('046), can be open to the surrounding environment. These holes will permit any medium to pass through them. The elements 52 present in Landes ('046) are attached to connecting tubes 53 through which the coating material SM is fed. The holes in Claim 1 can also accommodate a powder injection port nozzle as indicated by claims 17. Thus Claim 1 is allowable.

Claims 2-6 and 10 are also allowable since they depend from Claim 1 which has been placed in an allowable state by amendment.

Claim 13 also depends from Claim 1 and thus is allowable. Further, this claim is directed to frame element inner diameter D being at least as great as end piece inner diameter d. The cited prior art of Landes ('046) does not disclose this relationship for diameters. The specification of Landes ('046) does not provide the disclosure to these relative diameters. Also, the drawings cannot be used to supply this diameter relationship. As stated in MPEP §2125:

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.").

Thus, Claim 13 is allowable for the above reasons.

Claims 15-19 are allowable since they depend from allowable Claim 1. Further, Landes ('046) does not disclose the powder injection port nozzle. Landes ('046) discloses only "channels 52 having the shape of radially extending bores." Thus, the limitation found in Claims 17 is not disclosed by Landes ('046).

REJECTION UNDER 35 U.S.C. § 103:

Claims 7, 11, 12, 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Landes (5,406,046). These claims are not rendered obvious in light of the amendment to Claim 1 from which they depend. Further in regards to Claim 7, the Action suggests that the choice of ten radially oriented open through holes is a matter of routine design left to the discretion of the designer and dependent on the materials sprayed and the quality desired. The Action states that likewise the end-piece diameters called for in claims 11 and 12 are an obvious design choice for one of ordinary skill in the art. This rejection on obviousness grounds fails to make out a case

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for prima facie obviousness. The Office is reminded of MPEP §2144.03. Further rejection on obviousness grounds should include the reasoning and source of information.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, Order No. 07589.0053.NPUS01.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,



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